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In the Supreme Court of the United States

OCTOBER TERM, 1977

A. M. NAMIROWSKI,

Petitioner,

vs.

NABISCO, INC., a foreign corporation,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit.

OPINION BELOW

The Order of the Court of Appeals, entered November 28, 1977, is reprinted as Appendix A, post. Motion in Lieu of Petition for Rehearing (reprinted as Appendix B) was denied, December 14, 1977 (reprinted as Appendix C) post. The Memorandum Opinion of the District Court cited in the Order of the Court of Appeals, entered November 28, 1977, reprinted as Appendix B.

JURISDICTION

Jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254 (1). Questions under the United States Constitution sought to be reviewed by this Court were timely and properly raised in the Court below.

QUESTIONS PRESENTED

1. Whether the unpublished Order entered pursuant to Rule 35 of the Court of Appeals for the Seventh Circuit or Rule 35 itself violates the due process and equal protection provisions of the Fifth Amendment of the United States Constitution or violates the orderly administration of justice and appellate procedures by precluding meaningful petitions for rehearing, by preventing compliance with Supreme Court Rules governing petitions for writ of certiorari, by departure from the doctrine of stare decisis, by avoiding accountability and precluding peer review and by failure to specify under what guidelines of Rule 35 the unpublished order was entered so as to permit review.

2. Whether Summary Judgment was a proper procedure under the attendant facts and circumstances and inferences to be drawn therefrom where a jury was demanded.

a. Whether or not the requirements of *Graham* v. *John Deere Co.*, 381 U.S. 1 as to the obviousness of the invention, to-wit: the determination as questions of fact of the issues as to the scope and content of prior art, differences between the art and issues, the level of ordinary skill in the permanent art, secondary considerations such a long felt and desired need, the failure of others to solve that need and the like precluded Summary Judgment procedure in the instant case.

b. Whether or not under the dictates of the case of *Sakraida* v. *Ag Pro*, 96 S.Ct. 1532, 47 L.Ed. 2d 784, concerning the validity of combination patents, the District Court, under the facts and circumstances in the instant case could grant Summary Judgment, where it was required to make factual determinations as to "obviousness" and "synergism" (did the combination of old elements produce or not produce a result greater that the sum of the parts?).

3. Whether the decision of the District Court was undermined by its finding that no presumption of validity arose from the granting of the patent.

STATEMENT

This was a complaint based on a patent infringement Jurisdiction which was predicated under Article III Section 2 of the Constitution of the United States and Chapter 35 of the United States Code. The Petitioner at the time of the filing of the complaint made a jury demand.

The fundamental allegations stated that on June 10, 1969 Patent No. 300,448,698 was issued to Petitioner and that the Respondent had infringed on that patent.

The absence of any opinion by the Court of Appeals outlining the facts necessitates a recapitulation on the basis of the contents of the Affidavits filed in connection with the several Motions for Summary Judgments. They are as follows:

At the time of the issuance of the patent, the Petitioner was employed as a general laborer by Nabisco, the respondent; he was a man of limited facility in the English language. As a general laborer, his duties involved periodic cleaning of salt out of ovens used in making crackers, a dirty and difficult task involving scraping the salt from the oven; workers inhaling it choked and their health was

affected; to perform this cleaning, it was necessary to close the baking operations; the accumulations of salt affected the quality of crackers by contamination; the burners in the oven were affected by those salt accumulations.

These salt accumulations was a recognized problem in the industry, and was particularly troublesome to Nabisco.

Nabisco is a multi-national corporation and is the leading producer of crackers and cookies in the United States whose net sales in 1973 exceeded one and a half billion dollars; it maintained an engineering research and patent departments and commencing in 1952 attempted to devise several modes of operating the ovens to eliminate the accumulation of excess salt, all of which failed, including, a wire mesh system. In 1965, Petitioner, after Nabisco's failures, set out to invent a system which delivered cracker dough to the oven, successfully transported them to the ovens without distortion and eliminating salt from enterings ovens thereby precluding periodic cleaning, and the attendant problems of salt accumulation (contamination of the product, clogging of the burner put in Namirowski's patent). The patent issued was for a device that was primarily *designed to keep salt from entering ovens, thereby reducing and eliminating* the costly and unhealthy tasks of *cleaning* those ovens. It was designed to apply to the baking of crackers consisting of *separate pieces of dough,* to successfully *transport* them along the conveyor lanes and *transfer* them on to the oven band into the oven without distorting their shape or gumming up the machinery.

It was *designed* to prevent salt from entering the oven which, through accumulations on the burners, affected the temperature, the baking process and the quality of the product being baked.

It was designed to recapture the salt in such a manner, *without contamination of the salt* or the *distortion of the salt crystal,* so as to allow for the reuse of that salt.

These results were achieved in the invention through the use of:

a. A salt separating machine on a cracker line that uses a wire mesh belt without a side chain drive;

b. A wire mesh belt that works on small diameter noser roll;

c. A wire mesh belt that has small openings to support the premium line that is of a balance weave design;

d. A wire mesh belt that permits the salt to pass through;

e. A noser roll assembly of small diameter that has a plate or tracking guide or device; which permitted the successful transfer of the separate cracker dough into the oven;

f. A noser roll assembly that is split to prevent bending or bowing;

g. An air device or blower on the lower flight to remove any excess salt and prevent such salt from entering the oven;

h. A device to recapture the salt for recycling.

After issuance of a patent and its publication, Nabisco incorporated all of the ideas in the Namirowski patent on certain cracker baking lines in Chicago with the result that salt was eliminated from ovens and Namirowski patent involved recapture of the salt thereby allowing reuse of tons of salt in Nabisco's operation. It also appeared that the ideas incorporated in the Namirowski patent were used by Nabisco in a cracker line in Atlanta, Georgia which

marked success, illustrated by letters from Nabisco's superintendent in Atlanta claiming such success from the elimination of salt from the ovens with the elimination of periodic cleaning and attendant problems of salt accumulation.

Indeed, certain drawings used by Nabisco for the Atlanta operation were identical with the drawings in the Namirowski patent. All of the foregoing facts were not disputed by the affidavits submitted by the respondent in its several motion for Summary Judgment.

When Nabisco, after the successful elimination of salt from entering the ovens using Namirowski's patent, attempted to remove one of those ideas, namely, an air blower operating on the steel mesh, the problems of salt accumulation in the oven and periodic cleaning returned, which prevented salt from accumulating on the steel mesh, which accumulations would have been transferred into the oven.

In June of 1974, the Respondent filed its first Motion for Summary Judgment submitted with memorandum and affidavits which Motion was denied on September 12, 1974. Thereafter, in June of 1975, the case was taken off of the call of Judge Lynch and transferred to the calendar of Judge Flaum. In June of 1975, the Respondent filed a new Motion for Summary Judgment.

The Second Motion of the Defendant for Summary Judgment was based in the main, on the Affidavits and the facts related therein of:

a. John Barratt, Director, Simon-Vicars Limited—a manufacturer and seller of baking apparatus based in Great Britain but selling its apparatus in the United States and throughout the world, of London, England. (Record, Item 63, Attachment 1)

b. Joseph F. Lynch, Vice President, Schulze and Burch Biscuit Co. of Chicago, Illinois—a manufacturer of crackers including saltines and other baked goods. (Record Item 63, Attachment 2)

c. James E. Tiefenthaler, Jr., President, Tiefenthaler Machinery Company, Milwaukee, Wisconsin—a seller of baking equipment manufactured and mostly sold in the United States. (Record Item 63 Attachment 3)

d. Thomas R. Lugar, President, Thomas L. Green and Company, Inc., Indianapolis, Indiana—a manufacturer and seller of baking equipment in the United States. (Record Item 63, Attachment 4)

e. Walter Salter, Vice President, J. W. Greer, Inc. Wilmington, Massachusetts—a manufacturer and seller of baking equipment in the United States. (Record, Item 63, Attachment 5)

f. Harry A. Fischer, Market Manager, Biscuit, Cracker and Confectionery, Baker Perkins Inc., Saginaw, Michigan—a manufacturer and seller of baking equipment in the United States. (Record Item 63, Attachment 6)

In joining issue with the Second Motion for Summary Judgment, namely the Vicar's Patent, anticipation, prior art, novelty and obviousness, as created by the six affidavits the petitioner filed, among other documents, the affidavits of Adam Namirowski, inventor, Record Item 82, and Ronald Dorkin, an expert, Record Item 80, which contested the Vicar's Patent and the Affidavits items by item, affidavit by affidavit, fact by fact, applicability by inapplicability.

Read side by side with those affidavits filed in support of the second motion for summary judgment, the Namirowski and Dorkin affidavits raise factual contests on the

elemental issues of anticipation, prior art, novelty and obviousness. The affidavits of Namirowski and Dorkin deny that the devices outlined in the defendants affidavits or that the device described in the Vicar's Patent are "identical in nature, function and purpose to the invention described in the Namirowski Patent". Those *factual distinguishments* are outlined in detail in the Dorkin Affidavit (Record Item 80) Pages 15 through 30 and in the Namirowski Affidavit (Record Item 80) Pages 18 through 39. The Namirowski and Dorkin affidavits *factually* deny that the Namirowski Invention was precluded by anticipation, prior art, lack of novelty, or obviousness.

It is because of the very existence of these disputed questions of fact and the inferences to be drawn therefrom raised by these contrary affidavits as to the issues of anticipation, prior art, novelty and obviousness, that the plaintiff Namirowski maintains that the Second Motion for Summary Judgment should have been denied as was the First Motion for Summary Judgment.

Thereafter, on September 22, 1976, Respondent's Motion for Summary Judgment was granted. On November 28, 1977, the Court of Appeals entered its Memorandum Order not to be published affirming the decision of the District Court granting Summary Judgment.

On December 12, 1977, the Petitioner filed a Motion in Lieu of a Petition for Rehearing attacking the validity of the unpublished Order and respectfully requests the Court for a published opinion and for other appropriate relief; that the Motion in Lieu of the Petition for Rehearing was denied by the Court of Appeals on December 14, 1977.

REASONS FOR GRANTING WRIT

I.

THE UNPUBLISHED ORDER ENTERED PURSUANT TO RULE 35 OF THE COURT OF APPEALS FOR THE SEVENTH CIRCUIT, OR RULE 35 BY ITSELF, VIOLATES THE DUE PROCESS OF EQUAL PROTECTION DIVISIONS OF THE FIFTH AMENDMENT OF THE UNITED STATES CONSTITUTION AND VIOLATES THE ORDERLY ADMINISTRATION OF JUSTICE AND APPELLATE PROCEDURE.

Rule 35 of the Court of Appeals for the Seventh Circuit (Appendix D) is a rule promulgated by the Court of Appeals itself permitting the issuance of public opinions or unpublished orders. The Court in the instant case elected to decide the cause under an unpublished order. The dictates of Rule 35 command that such an unpublished order shall be typewritten and reproduced by copy machine, shall be distributed to the District Judge and the counsel or the news media, shall be available for listing periodically in the Federal reporter showing only the operative words of the order that is, affirmed, etc. and shall not be used or cited as precedent, that is, fall within perimeters of stare decisis.

In particular, unpublished orders may be filed in appeals which are:

1. Frivolous.

2. Present no question sufficiently substantial to require explanation i.e. a controlling statute or decision which determines the appeal or the issues which are factual only

and the judgment appealed from is supported by the evidence or where the order appealed is non-applicable or the court lacks jurisdiction or the appellant lacks standing.

Alternatively, unpublished orders may be utilized in appeals which are not frivolous but present arguments concerning the application of recognized rules of law which are sufficiently substantial to warrant explanation but are not of general interest or importance.

It should be noted that under these categories, the guidelines do not contain the requisite finding by the Court issuing the unpublished order to designate under what portion of Rule 35 the unpublished order is based.

The failure of the guidelines to contain this requirement precludes the litigant and more importantly the Supreme Court from determining the validity of the basis for the issuance of such an unpublished order.

The failure of the guidelines to contain this fundamental concept thus bars the litigant from testing the accuracy and fairness of the Court issuing the unpublished opinion. Procedures are established with unbridled power and are violative of any minimal standards regarding due process of equal protection of the law.

Moreover, the very existence of Rule 35 allowing unpublished orders without such limitation serves to extinguish a significant and vital appellate procedure, namely, the Motion for a Rehearing. That procedure has been attendant in appellate litigation at every plateau; it offers an opportunity to point out to the Court wherein it's felt its reasoning and rationale has departed from precedent or the decisions of higher courts.

The unpublished order renders such a procedure a nullity. It would appear that if appellate review is to be limited, such limitations should not be promulgated by

the very Court that is obligated to make the decisions. The extirpation of this valuable right is clearly violative of the due process and equal protection provisions of the Fifth Amendment.

The utilization of the unpublished order further serves to deprive the litigant of a most significant right, that is, the right to petition for a writ of certiorari in the Supreme Court of the United States. While the right to a review on a writ of certiorari is not a matter of right, the petition is part and parcel of orderly appellate procedures sanctioned since the birth of the Federal judicial system.

Within the perimeters of the rules of the Supreme Court concerning the petition for writ of certiorari, in particular, the rules with respect to brevity and in particular, with respect to Rule 19 (1b). concerning the special and important reasons necessary for the successful granting of the writ, the unpublished order serves to effectively bar the presentation of a petition that conforms with said rule.

In the instant case, without the benefit of the specificity that a published opinion would provide, considering that the record on appeal was in excess of 1,000 pages, involving multiple depositions and multiple affidavits as well as contesting briefs filed in the Motions for Summary Judgment, a brief of the Petitioner consisting of 69 pages, a brief of Respondent consisting of 67 pages and a reply brief of the Petitioner consisting of 12 pages. It is impossible to distill under the guidelines of brevity and the elements that the Supreme Court is to consider of importance . . . for the granting of the writ. The Petitioner, through the unpublished order is prevented from showing that the Court of Appeals "has rendered a decision in conflict with the decision of another Court of Appeals on the same matter . . . or has decided an important question of Fed-

eral law which has not been, but which should be settled by this Court; or has decided a Federal question in a way in conflict with applicable decisions of this Court; or has so far departed from the accepted and usual course of judicial proceedings or so far sanctioned such a departure by a lower court as to call for an exercise of this Court's power supervision. . ."

The preparer of a petition for a writ of certiorari faced with an unpublished order must speculate and conjecture as to what the Court of Appeals had in its mind when it issued that unpublished order.

Most significantly by permitting the Court of Appeals of the Seventh Circuit to establish a Rule which in effect determines what cases shall be added to the body of stare decisis and which cases will not is destructive of the very basis for stare decisis which is the bulwark of the common law. In effect, the Court of Appeals has removed from peer review a mass of cases from which the prior doctrines of stare decisis are effectively barred because no lawyer, no judge, not even the Supreme Court has a reasoned opinion upon which to determine whether or not the Court of Appeals has followed stare decisis. This lack of accountability creates a reservoir of cases that defy inspection. These cases are immune from analysis; Rule 35 represents a return from the Courts of common law to the Court of a sovereign that is, giving reasons for its decision. This lack of accountability creates a reservoir of cases where unpopular decisions, or decisions that do not follow the doctrine of stare decisis, may be buried. This lack of accountability creates a reservoir of cases which subjects appellate tribunals to the "appearance of impropriety", a world of watergates, procedures which allow such speculations by lay persons should not be sanctioned.

The writer of this petition is not unmindful of the enormous burden placed upon Courts of review by dint of the multiplication of law suits and appeal procedures. It is felt that the answer to those problems is not in the expedient of Rule 35 and requests that the Supreme Court of the United States subject that rule to its scrutiny.

It is time for the Supreme Court to require the Court of Appeals for the Seventh Circuit to inform the litigant under what provisions or guidelines it is issuing its unpublished order.

II.

SUMMARY JUDGMENT SHOULD NOT HAVE BEEN GRANTED TO THE PETITIONER UNDER THE FACTS AND CIRCUMSTANCES OUTLINED BY THE CONFLICTING AFFIDAVITS. THE TRIAL COURT WAS PRECLUDED FROM DECIDING THIS CASE BY WAY OF SUMMARY JUDGMENT UNDER THE AUTHORITY OF THE GRAHAM AND SAKRAIDA CASES; THE TRIAL COURT IGNORED THE DEMANDS OF THOSE DECISIONS; THE TRIAL COURT IGNORED THE BASIC REQUISITES UNDERLYING SUMMARY JUDGMENT; THE COURT OF APPEALS BY ITS UNPUBLISHED ORDER SANCTIONED SUCH DEPARTURES BY A LOWER COURT AS TO CALL FOR AN EXERCISE OF THE POWER OF SUPERVISION OF THE SUPREME COURT.

The petitioner contends that the use and granters of the Second Motion for Summary Judgment was inappropriate and erroneous, that the affidavits of Namirowski and Dorken created disputed questions of fact or undisputed facts that gave rise to inferences that precluded summary judgment as a means of disposing of this litigation.

It is axiomatic that summary judgment can be granted only if "there is no genuine issue as to any material fact

and that the moving party is entitled to a judgment as a matter of law." (Rule 56, Fed.R.Civ.Procedure)

With respect to summary judgment in patent cases, the standard to be applied in passing on motions for summary judgment was stated in *Bohn Aluminum & Brass Corp.* v. *Storm King Corp.*, 303 F.2d 425, 427 (6th Cir. 1962), as follows:

> "In ruling on a motion for summary judgment, the court must construe the evidence in its most favorable light in favor of the party opposing the motion and against the movant. Further, the papers supporting the movant are closely scrutinized, whereas the opponent's are indulgently treated. 6 Moore's Federal Practice Par. 56.15 (3), pp. 2123-2126.
>
> "It has been stated that: 'The purpose of the hearing on the motion for such a judgment is not to resolve factual issues. It is to determine whether there is any genuine issue of material fact in dispute * * *,' 6 Moore's Federal Practice Par. 56-11(1), p. 2057. See also: Poller v. Columbia Broadcasting System, Inc., 368 U.S. 464, 82 S.Ct. 486, 7 L.Ed.2d 458 (1962)."

It would appear that under the application of this principle that summary judgment in Patent cases is the rare exception, *Ronal Corporation* v. *Anchor Lock of Florida, Inc.*, 5 Cir. 1963, 325 F.2d 889 and not the rule in patent infringement cases. *Inglett & Company* v. *Everglades Fertilizer Company*, 5 Cir. 1958, 255 F.2d 342. . .

The Courts have in reviewing the applicability of the Summary Judgment process in Patent disputes, stated that "unusual Caution must be exercised before Summary Judgment is granted in a patent case and that the defendant in the patent infringement action bears a heavy burden of showing that no genuine issue of fact exists." *Xerox Corporation* v. *Dennison Manufacturing Company*, 322 Federal

Supplement 936 at Page 966. Continuing this case in detail considered the range of Motions for Summary Judgment and stated "In considering defendants' Motion for Summary Judgment, we are governed by the basic principle that defendants bear the heavy burden of showing that no genuine issue exists as to any material fact necessary to establish defenses entitling them to dismissal as a matter of law. *Dolgow* v. *Anderson*, 438 F.2d 825 (2d Cir. Sept. 1970)."

Indeed it ought be noted that such reluctance to grant Summary Judgment should be magnified where in this case a *jury has been demanded.* Therefore the customary procedure in patent cases of a Judge sitting both as the trier of facts, and their inferences or the trier of law does not exist in this case. The distinction between questions of fact and law should be keenly observed, particularly in Motions for Summary Judgment in order that the plaintiff not be deprived of a trial by jury.

What are the factual considerations to be determined in deciding the validity or invalidity of a patent. The Supreme Court, in *Graham* v. *John Deere Co.*, 383 U.S. 1, inspecting the Patent Act of 1952, declared, at page 17,

> "While the ultimate question of patent validity is of law, A. & P. Tea Co. v. Supermarket Corp., supra, at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, *the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level or ordinary skill in the pertinent art resolved.* Against this background, the *obviousness* or *nonobviousness* of the subject matter is determined. Such secondary considerations as *commercial success, long felt unsolved needs, failure of others,* etc., might be utilized to give

light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. See Note, Subtests of 'Nonobviousness': A Nontechnical Approach to Patent Validity, 112 U. Pa. L. Rev. 1169 (emphasis added)."

That pronouncement has formed the backbone in defining what constitutes the battleground of "contested or disputed" issues of fact. If such a contest exists, the summary judgment shortcut is forbidden.

Its application is best exemplified in *Buzzelli* v. *Minnesota Mining and Manufacturing Company*, 480 F.2d 541, at page 542:

"Several factual inquiries must first be made under 35 U.S.C. § 103. The court must ascertain the status of the particular art at the time of invention, the difference between the state of the art at that time and the claims at issue, and the level or ordinary skill in the art during the questioned period. *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

Upon the basis of conflicting affidavits, the District Court resolved factual issues relating to obviousness. The determination of this issue calls for a factual inquiry regarding the experience of those skilled in the art. The affidavits are in conflict on this crucial factual question, creating a genuine issue of material fact.

We, therefore, hold that the District Court erred in granting summary judgment."

In the instant case the undisputed facts that there was an industry problem of salt accumulation which Nabisco, with its vast resources could not solve; which Nabisco attempted to solve and failed; the adoption by Nabisco of all of the ideas in the Namirowski Patent and its success-

ful use in Chicago and Atlanta all point to the inescapable conclusion that the Namirowski invention was not obvious; yet the District Court had to conclude, to enter summary judgment, that it was obvious and in doing so entered into the arena of fact determination.

The importance of those findings by the trier of fact was stressed in a non-summary judgment decision in the 7th Circuit, *Popeil Brothers, Inc.* v. *Schick Electric, Inc.*, 494 F.2d 162 (1974) at page 167:

"The District Court additionally premised its conclusion as to the invalidity of the patent in suit on the finding that the patent was obvious under 35 U.S.C. Sect. 103. In determining the obviousness or nonobviousness of a purported invention, the Trial Court must make a number of factual inquiries and specifically express, as did the District Court herein, its findings as to each. Rockwell v. Midland Ross Corporation, 438 F.2d 645, 651-652 (7th Cir. 1971); Gass v. Montgomery Ward & Co., 387 F.2d 129, 130 (7th Cir. 1967); Cloud v. Standard Packaging Corporation, 376 F. 2d 384, 391 (7th Cir. 1967). The Court must determine: (1) the scope and content of prior art; (2) the differences between the prior art and the claim or claims at issue; (3) the level of ordinary skill in the pertinent art; (4) the presence or absence of such secondary factors as commercial success, long felt but unsolved needs and failure of others. Graham v. John Deere Co., 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966)."

If such an expression of the state of the law is valid and appertains, in the instant case, where a jury has been demanded, where the District Court is thereby excluded from factual decisions or any considerations of inferences to be drawn from those facts if there are any questions of fact on these issues, the error in utilizing the summary judgment route is doubly magnified.

It is significant that nowhere in the District Courts' opinion were the tenets of the *Graham* Case set forth; nowhere were the findings or non-findings of fact interpreting the opposing affidavits, by this land-mark case explored or analyzed.

The Court of Appeals for the 7th Circuit by its unpublished order buries any explanation of the apparent conflict between the decision of the District Court and the prior decisions of the Court of Appeals for the 7th Circuit.

This further illustrates the inappropriateness of an unpublished order under Rule 35 without any specification.

The Court of Appeals by its unpublished opinion has sanctioned such a departure by a lower Court from the accepted and usual course of judicial proceeding as to call for an exercise of the Supreme Court power of supervision.

The District Court in its Memorandum Opinion (Appendix E), at App. 23 declared:

> "Thus, before a Court even considers whether or not there does exist a long-felt need for the purported invention, the Court must determine that the combination of old elements produces a result greater than the sum of the parts."

The Court arrived at this conclusion on the basis of what it considered the meaning was in the Supreme Court's decision in *Sakraida* v. *Ag Pro, Inc.*, 96 S. Ct. 1532 (1976) and *Dann* v. *Johnston*, 96 S. Ct. 1393 (1976). The District Court declared that those cases "make it clear that the plaintiff's claim 4 is obvious and invalid. In *Sakraida* the Court pointed out that even if a device is commercially successful and fulfills a long-felt need in an industry, a combination patent is still obvious and invalid where the reordering of known elements fail to produce a synergistic result. 96 S. Ct. at 1537."

The irony of this interpretation is that it required the District Court to make a factual determination "that the combination of old elements produces a result greater than the sum of the parts." This fact consideration is precluded in a motion for Summary Judgment, particularly in the light of the claim of Namirowski that his invention kept salt from entering the ovens and eliminated the problems of salt accumulation; in particular the cleaning of the ovens, which accomplishment and result was never contradicted by the Respondent's Affidavits.

The irony was that the Namirowski invention did produce a result greater than the sum of its parts. It prevented salt from entering the oven; it eliminated the cleaning of the ovens, a result, it is claimed, which was never achieved in the cracker baking industry.

As previously observed in this argument, the District Court in its Memorandum Opinion, pages 13 and 14 took the position that the *Sakraida* case, 96 S.Ct. 1532 (1976) authorized and required the District Court to remove from its consideration the need for such a device (the Namirowski Invention) the industry problem, the unsuccessful attempts by Nabisco to solve the problem, the "success" of the Namirowski Patent, in short to disavow the factual considerations required in the *Graham* v. *John Deere* case.

This simply is not accurate. The Court in fact, reaffirmed the precepts of the *Graham* case. It stated at page 1535,

> "The ultimate test of patent validity is one of law, A&P Tea Co. v. Supermarket Corp., 340 U.S. 147, 155, 71 S.Ct. 127, 131, 95 L.Ed. 162, 168 (1950), but resolution of the obviousness issue necessarily entails several basic factual inquiries, Graham v. John Deere Co., supra, 383 U.S. at 17, 86 S. Ct. at 693, 15 L.Ed.2d at 556.

> *"Under § 103, the scope and content of the prior art to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."* *Ibid.*

In the *Sakraida* case there had been a *trial* in the District Court and the District Court, as the trier of fact on a disputed issue, made findings of fact upon which it concluded obviousness.

Said the Supreme Court at page 1536,

> "Our independent examination of that evidence persuaded us of its sufficiency to support the District Court's *finding 'as a fact* that each and all of the component parts of this patent . . . were old and well-known throughout the dairy industry long prior to the date of the filing of the application for the Gribble patent . . . (w)hat Mr. Gribble referred to . . . as the essence of the patent, to-wit the manure flush system, was old, various means for flushing manure from dairy barns having been used long before the filing of the application . . .' "

No such trial, no such finding of fact attends the Namirowski case. The question of "obviousness" as a fact is hotly contested in the Namirowski and Dorken affidavits.

What the Supreme Court said in the *Sakraida* case is that the Circuit Court of Appeals should not substitute its judgment for that of the trier of fact.

The District Court in its Memorandum Opinion in the Namirowski case, in order to find whether or not the Namirowski Patent did or did not produce a synergistic result "must determine that the combination of old elements produces or not produces a result greater than the sum of the parts." (App. 23, 24, 25)

Such a determination clearly demands an evaluation of material facts which are disputed; whether or not the devices and procedures outlined in the affidavits filed by the Respondent in its Motion prevented salt from entering the ovens with the attendant problems of salt accumulation including cleaning; the prior art before the Namirowski Invention; whether or not the devices cited by the defendant are congruent or identical with the Namirowski Invention; whether or not they achieve the same result; whether or not they were intended to achieve the same result.

Under the law applying to motions for summary judgment the District Court was precluded from making a determination.

Accordingly, the District Court could not utilize *Sakraida* to avoid the factual considerations commanded by the *Graham* case in the motion for summary judgment.

In the instant case, the Namirowski Patent in fact produced a "new or different function". It, in effect, as demonstrated by the "commercial success" eliminated salt from the oven and consequently periodic cleaning. It cured and eliminated the problem created by accumulations of salt within the oven.

Synergistic is generally defined as a new result or function arising from the combination of elements that severally could not produce the function or result achieved.

Sakraida v. *Agpro, Inc.*, 965 Ct. 1532, at page 1537 defined synergistic as

> *"resulting in an effect greater than the sum of the several effects taken separately."* Anderson's-Black Rock v. Pavement Co., 396 U.S. 57, 61, 90 S.Ct. 305, 308, 24 L.Ed.2d 258, 261 (1960).

In the *Sakraida* case the flushing produced the same effect or result as its several parts, albeit more rapidly and efficiently. The combination did not produce a new function or a new result as did the Namirowski Patent.

The District Court, in the instant case, confirmed the fact that combination in the Namirowski Patent resulted in the elimination of *all* excess salt from the oven (Opinion pg. 14). In so doing the District Court confirmed the elimination of periodic cleaning, for no salt means no accumulation, means no "problems". In so doing, the District Court confirmed the new function, the new result, the synergism.

The Court of Appeals for the 7th Circuit by its unpublished order buries any explanation of the apparent conflict between the decision of the District Court and the *Sakraida* decision.

This further illustrates the inappropriateness of an unpublished order under Rule 35 without any specification.

The Court of Appeals by its unpublished opinion has sanctioned such a departure by a lower Court, such a departure from the accepted and usual course of judicial proceeding as to call for an exercise of the Supreme Court power of supervision.

III.

THE BASIS OF THE DECISION OF THE DISTRICT COURT NAMELY, THAT NO PRESUMPTION OF VALIDITY AROSE FROM THE GRANTING OF THE PATENT WAS ERRONEOUS AND UNDERMINED THE GRANT OF SUMMARY JUDGMENT.

The District Court in the instant case on App. p. 19 (Appendix E) of its opinion as a basic predicate for its decision, declared:

> "Moreover, although the plaintiff argues that the presumption of patent validity mandates extreme caution in summary judgment motions challenging a patent's validity in this case, no such presumption exists. . ."

Such a perception is inaccurate in the light of the decision of the Court of Appeals for the 7th Circuit, in *Chicago Rawhide Manufacturing Co.* v. *Crane Packing Co.*, a non Summary Judgment case, 523 F.2d 452 (1975), that Court at page 457, stated:

> "Plaintiff's principal argument is that 'the district court erred as a matter of law in failing to heed prop-
> a patent is presumed valid'. . .
> erly the mandate of the statute 35 U.S.C. Sec. 282 that
>
> Section 282 provides, in part:
>
> 'A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claim shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim then shall rest on the party asserting it'. . . ."

There are two aspects to the presumption of validity. First, as a matter of procedure, Sec. 282 places the burden of persuasion on the party attacking the validity of the patent. *This burden remains upon the alleged infringer throughout the proceeding and is in no sense dependent on the character of the proceedings before the Patent Office or the amount of prior art cited to, or considered by, the Patent Examiner. In its first aspect, the presumption is constant.*

Indeed, it would appear that to overcome that presumption there must be clear and convincing evidence of invalidity. See *Reese* v. *Elkhart Welding & Boiler Works, Inc.*, 447 F.2d 517, 527 (7th Cir. 1971).

It thus appears that the District Court, in prefacing its decision that there was *no* presumption of validity (a presumption being a legal *fact* or a *factual* equivalent) such a finding undermines the very foundation of a decision having as its focus whether or not there were any material questions of fact.

It thus appears that the District Court failed to put the dependent's motion and affidavits to the test; that the presumption of validity must be overcome by *clear and convincing* evidence of invalidity.

The Court of Appeals for the 7th Circuit by its unpublished order buries any explanation of the apparent conflict between the decision of the District Court and the prior decisions of the Court of Appeals for the 7th Circuit.

This further illustrates the inappropriateness of an unpublished order under Rule 35 without any specification.

The Court of Appeals by its unpublished opinion has sanctioned such a departure by a lower Court from the accepted and usual course of judicial proceeding as to call for an exercise of the Supreme Court power of supervision.

CONCLUSION

For all of the foregoing reasons, it is respectfully prayed that a Writ of Certiorari issue to the Court of Appeals for the Seventh Circuit.

Respectfully submitted,

ALAN D. KATZ
BURTON S. GOULD

Attorneys for Petitioner

Of Counsel:
DAVID S. POCHIS
and
ALAN D. KATZ

APPENDIX

APPENDIX A

Unpublished Per Curiam Order

UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT
Chicago, Illinois 60604

November 28, 1977

Before
Hon. Robert A. Sprecher, Circuit Judge
Hon. Philip W. Tone, Circuit Judge
Hon. William J. Bauer, Circuit Judge

A. M. NAMIROWSKI,

Plaintiff-Appellant,

No. 76-2152 vs.

NABISCO, INC., a foreign corporation,

Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division
No. 73-C-196
Joel M. Flaum, *Judge*.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, AFFIRMED, with costs, in accordance with the order of this court entered this date.

UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT
Chicago, Illinois 60604

(ARGUED SEPTEMBER 15, 1977)
November 28, 1977

Hon. Robert A. Sprecher, Circuit Judge
Hon. Philip W. Tone, Circuit Judge
Hon. William J. Bauer, Circuit Judge

Unpublished Order Not To Be Cited
Per Circuit Rule 35

A. M. NAMIROWSKI, Plaintiff-Appellant,

No. 76-2152 vs.

NABISCO, INC., a foreign corporation,
Defendant-Appellee.

Appeal from the United States District Court for the
Northern District of Illinois, Eastern Division
No. 73-C-196
Joel M. Flaum, *Judge*.

O R D E R

The court has examined the briefs and the record and concludes that the judgment must be affirmed. We are not insensitive to the plaintiff's sincere belief that he made a valuable invention. It is not within our authority, however, to reward merit whenever we conceive it to be deserving. We are obliged to apply the principles of the patent laws to determine whether the plaintiff's patent is valid, and when we do so we are forced to conclude that it is not. The reasons that require that conclusion are those stated in the Memorandum of Opinion and Order entered by the District Court on September 15, 1976, which opinion we adopt.

The judgment is affirmed.

APPENDIX B

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT
No. 76-2152

A. M. NAMIROWSKI,
Plaintiff-Appellant,

No. 76-2152 vs.

NABISCO, INC., a foreign corporation,
Defendant-Appellee.

Appeal from the United States District Court for the
Northern District of Illinois, Eastern Division.
Honorable Joel M. Flaum, Judge Presiding.

MOTION IN LIEU OF PETITION FOR REHEARING

Now comes the Plaintiff-Appellant, A. W. Namirowski, and moves the Court to strike the unpublished Order not to be cited per Circuit Rule No. 35 entered by this Court on or about November 28, 1977 affirming the Memorandum of Opinion and Order entered by the District Court on September 15, 1976 which opinion was adopted in said unpublished Order and respectfully requests the Court for a published opinion and for such other relief the Court deems fit and proper on the following grounds:

1. That said unpublished Order is contrary to orderly, judicial and appellate procedure in that without the specifications or the reasoning of the Court as to the basis of their opinion, the Plaintiff-Appellant, A. M. Namirowski, is precluded from filing a Petition for Rehearing in which the Plaintiff-Appellant might point out to the Court any

errors in its reasoning or basis for its Order or decision; that deprivation constitutes the loss of an important and significant right, namely, the right to Petition the Court for rehearing.

2. That said unpublished Order is contrary to the Fifth Amendment of the United States Constitution in that the Plaintiff-Appellant, A. M. Namirowski, is deprived of due process of law because the rendition of the Order without specifications or reasons as to the basis of the said decision and the Order precludes the Plaintiff-Appellant from filing a meaningful Petition for rehearing as allowed under the Federal Rules of Appellate procedure wherein the Plaintiff-Appellant is thereby precluded from informing or pointing out to the Court any errors that underlie any Order or decision.

3. That said unpublished Order is contrary to the Fifth Amendment of the United States Constitution in that the Plaintiff-Appellant, A. M. Namirowski, is precluded from drafting and formulating from within the Supreme Court Rules of the United States a meaningful Petition for a Writ of Certiorari to the said Supreme Court based upon specific claims of error in the Appellate Court of Appeals Order of opinion; that the said unpublished Order serves to prevent the Plaintiff-Appellant from such specificity as to the issue and opinions rules on the Court of Appeals under which the Supreme Court might take the case on appeal.

4. That said unpublished Order is contrary to the Fifth Amendment of the United States Constitution in that the Plaintiff-Appellant, A. M. Namirowski, is deprived of due process of law because the rendition of the Order without specifications or reasons as to the basis of the said decision and the Order precludes the Plaintiff-Appellant from drafting and formulating a meaningful Petition for a Writ of Certiorari to the said Supreme Court based upon specific claims of error in the Appellate Court of Appeals Order of opinion; that the said unpublished Order serves to prevent the Plaintiff-Appellant from such specificity as to the issue and opinions rules on the Court of Appeals under which the Supreme Court might take the case on appeal.

5. That the said unpublished Order is contrary to orderly, judicial and appellate procedure in that the said unpublished Order is by reason of its matter and secrecy does not subject the Court of Appeals to peer scrutiny or accountability to the judges, lawyers, legal scholars or the general public; that accordingly, such unpublished Orders are contrary to a free and open society; that further the use of said unpublished Orders is violative of the common Appellate Law based upon the doctrine stare decisis in that said unpublished Orders and opinions may well be based on principles of law contrary to stare decisis; that said unpublished opinions by reason of their secrecy with respect to their legal predicate and reason and reasoning by their said decision makes such a manner of decision subject to the use in matters that are unpopular and that such secrecy carries within it the potential of abusive power.

6. That the said unpublished Order is contrary to the Fifth Amendment of the Supreme Court in that the Plaintiff-Appellant, A. M. Namirowski is deprived of due process of law in that said Order without specificity or the reasons upon said Order is based in that the same violates the principles of stare decisis.

7. That the said unpublished Order is contrary to orderly, judicial and appellate procedure in that the same violated the guidelines of Rule No. 35 of the Seventh Circuit Court of Appeals.

8. That the said unpublished Order is contrary to orderly, judicial and appellate procedure in that the same violated the guidelines of Rule No. 35 of the Seventh Circuit Court of Appeals in that the said unpublished Order failed to set out and specify under what provisions of Rule No. 35 it was being issued and the reason for it being issued under said Rule No. 35; that said failure precluded any appellate review of the courts decision to so decide the cause as an unpublished opinion.

9. That in the instant case involved substantial questions as to the use of Summary Judgment procedure in patent cases where a jury trial has been demanded whether or not there were any material facts that precluded Summary Judgment in the instant case; whether or not the District Court erred in failing to take into consideration for determination the requirements of *Graham* v. *John Deere Co.*, 383 US 1, to-wit: the Scope and Content of prior art, differences between the prior art and the claims at issue; the level of ordinary skill in the pertinent art; secondary considerations such as long felt but unresolved need, failure of others and the like; on all of which factual issues the Appellant claimed issues of material fact or inferences of fact favorable to the Appellant; whether or not the Court in a Motion of Summary Judgment could make a determination on the subject of combination patents as apposed in the *Sakraida Case* 96 C. Ct. 1537, 47 L. Ed. 2d 784 (1976). whether or not the invention of the Plaintiff-Appellant constituted a "new or different function or result" under the Sakraida case; whether or not the invention of Plaintiff-Appellant, A. M. Namirowski was "synergestic"; that all of the foregoing issues were covered in the instant case with an Appeal records in excess of 1,000 pages involving multiple depositions and multiple affidavits as well as briefs filed in two separate Motions for Summary

Judgments in the District Court, an Appendix consisting of 178 pages, brief of appellant consisting of 69 pages, brief and argument of Appellee consisting of 67 pages and a reply brief consisting of 12 pages; that the issues raised in those briefs concerned interpretations of previous interpretations of the United States District Court and their appeals to the instant case; that under the standard set forth in Rule No. 35 the said cause should properly have been decided under a written opinion and that the use of the unpublished Order substantially deviated from the guidelines of the said Rule No. 35.

10. That accordingly, the said unpublished Order entered on or about November 28, 1977 per Rule No. 35 is defective in that it fails to show under what standard of Rule No. 35 it was issued; that said failure precludes any effective inspection by which to contest said Order and its issuance.

Wherefore, plaintiff-appellant, A. M. Namirowski, prays judgment that the Court strike the unpublished Order entered on or about November 28, 1977 and requests the Court for a published opinion and for such other relief the Court deems fit and proper.

/s/ *Alan D. Katz*
Alan D. Katz, Attorney
for Plaintiff-Appellant

Please Take Notice That on December 12, 1977 I filed a Motion in Lieu of Petition for Rehearing in the United States Court of Appeals for the Seventh Circuit on the case of A. M. Namirowski vs. Nabisco, Inc., a foreign corporation.

/s/ *Alan D. Katz*
Alan D. Katz

I, Alan D. Katz, being duly sworn under oath, deposes and says that he served this Motion in Lieu of Petition for Rehearing in the United States Court of Appeals for the Seventh Circuit to Sidly & Austin, One First National Plaza, Chicago, Ill. 60602, by mailing a copy this 12th day of December, 1977.

/s/ Alan D. Katz

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT
Chicago, Illinois 60604

December 14, 1977.

Before
Hon. Robert A. Sprecher, Circuit Judge
Hon. Philip W. Tone, Circuit Judge
Hon. William J. Bauer, Circuit Judge

A. M. NAMIROWSKI,

Plaintiff-Appellant,

No. 76-2152 vs.

NABISCO, INC., a foreign corporation,

Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division
No. 73-C-196
Joel M. Flaum, *Judge*.

O R D E R

On consideration of the motion in lieu of petition for rehearing filed in the above-entitled cause by plaintiff-appellant, all of the judges on the original panel having voted to deny the same,

It Is Hereby Ordered that the aforesaid motion in lieu of petition for rehearing be, and the same is hereby, DENIED.

APPENDIX D

Circuit Rule 35. The following rule is the Plan for Publication of Opinions of the Seventh Circuit promulgated pursuant to resolution of the Judicial Conference of the United States.

(a) *Policy.* It is the policy of this circuit to reduce the proliferation of published opinions.

(b) *Publication.* The court may dispose of an appeal by an order or by an opinion, which may be signed or per curiam. Orders shall not be published and opinions shall be published.

(1) "Published" or "publication" means:

(i) Printing the opinion as a slip opinion;

(ii) Distributing the printed slip opinion to all federal judges within the circuit, legal publishing companies, libraries and other regular subscribers, interested United States attorneys, departments and agencies, and the news media;

(iii) Permitting publication by legal publishing companies as they see fit; and

(iv) Unlimited citation as precedent.

(2) Unpublished orders;

(i) Shall be typewritten and reproduced by copying machine;

(ii) Shall be distributed only to the circuit judges, counsel for the parties in the case, the lower court judge or agency in the case, and the news media, and

shall be available to the public on the same basis as any other pleading in the case;

(iii) Shall be available for listing periodically in the Federal Reporter showing only title, docket number, date, district or agency appealed from with citation of prior opinion (if reported) and the judgment or operative words of the order, such as "affirmed," "enforced" "reversed," "reversed and remanded," and so forth;

(iv) Except to support a claim of *res judicata*, collateral estoppel or law of the case, shall not be cited or used as precedent (a) in any federal court within the circuit in any written document or in oral argument or (b) any such court for any purpose.

(c) *Guidelines for Method of Disposition.*

(1) Published opinions: Shall be filed in signed or per curiam form in appeals which

(i) Establish a new or change an existing rule of law;

(ii) Involve an issue of continuing public interest;

(iii) Criticize or question existing law;

(iv) Constitute a significant and non-duplicative contribution to legal literature

(A) by a historical review of law;

(B) by describing legislative history, or

(C) by resolving or creating a conflict in the law; or

(v) Reverse a judgment or deny enforcement of an order when the lower court or agency has published an opinion supporting the order.

(2) Unpublished orders:

(i) May be filed after an oral statement of reasons has been given from the bench and may include only, or little more than, the judgment rendered in appeals which

(A) are frivolous or

(B) present no question sufficiently substantial to require explanation of the reasons for the action taken, such as where

(aa) a controlling statute or decision determines the appeal;

(bb) issues are factual only and judgment appealed from is supported by evidence;

(cc) order appealed from is non-appealable or this court lacks jurisdiction or appellant lacks standing to sue; or

(ii) May contain reasons for the judgment but ordinarily not a complete nor necessarily any statement of the facts, in appeals which

(A) are not frivolous but

(B) present arguments concerning the application of recognized rules of law, which are sufficiently substantial to warrant explanation but are not of general interest or importance.

(d) *Disposition is to be by Order or Opinion.*

(1) The determination to dispose of an appeal by unpublished opinion shall be made by a majority of the panel rendering the decision.

(2) The requirement of a majority represents the policy of this circuit. Notwithstanding the right of a single federal judge to make an opinion available for publication, it is expected that a single judge will ordinarily respect and abide by the opinion of the majority in determining whether to publish.

(3) Any person may request by motion that a decision by unpublished order be issued as a published opinion. The request should state the reasons why the publication would be consistent with the guidelines for disposition of appeals as set forth in this rule.

APPENDIX E

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

A. M. NAMIROWSKI,

Plaintiff,

vs.

NABISCO, INC., a foreign corporation,

Defendant.

73 C 196

MEMORANDUM OPINION AND ORDER

Joel M. Flaum, District Judge:

This cause is before the court on defendant's motion for summary judgment.[1] Defendant seeks: (1) the dismissal of plaintiff's complaint; (2) judgment on its counterclaim declaring invalid U.S. Patent No. 3,448,698 which was issued to plaintiff on June 10, 1969. For the reasons set forth *infra*, defendant's motion is granted.

A. Nature of U. S. Patent No. 3,448,698

The nature and operation of plaintiff's device is quite simple. The patent describes an apparatus which is used

[1] It should be noted that this is defendant's second motion for summary judgment. However, because the defendant has presented this court with relevant information not accompanying its first motion, *i.e.*, the deposition of Ronald Dorken, this court can properly accept and rule on the pending motion. *See Brownfield* v. *Landen*, 307 F.2d 389, 393 (D.C. Cir.), *cert. denied*, 371 U.S. 924 (1962); *Allstate Fin. Corp.* v. *Zimmerman*, 296 F.2d 797, 799 (5th Cir. 1961); 6 J. Moore, Federal Practice ¶ 56.14[2] (1974).

in the handling and making of food products, particularly crackers. In the usual production of crackers, the raw dough is placed in separate pieces onto a conveyor belt which is passed beneath a salt-spreading machine used to deposit salt onto the dough. These uncooked pieces of salted dough are then moved by the conveyor into an oven where the cooking of the crackers takes place. Plaintiff's "improvement" consists primarily of two parts: first, a *wire mesh conveyor belt*, containing openings small enough to support the dough but large enough to allow salt to pass through, which accepts the unbaked cracker dough from a separate conveyor system before the dough reaches the salting machine and which carries the dough beneath the salting device thereupon depositing the salted dough pieces onto a third conveyor belt which leads to the oven; and second, a *collecting means, i.e.*, a pan, located beneath the wire mesh conveyor belt and the salting machine which collects the salt not deposited on the unbaked dough after it passes through the wire mesh belt. Furthermore, the patent describes an *air blowing device* which directs forced air against the wire mesh belt on its return trip thereby forcing any salt which adhered to the belt to fall into the collecting means.

The purpose of the invention is also quite simple. By means of a wire mesh conveyor belt, any excess salt which is not placed on the unbaked dough will pass immediately through the wire mesh and never reach the baking ovens. This is important in the cracker industry as when salt enters the ovens periodic cleanings are needed which delay production. Plaintiff claimed in his patent that "virtually all" the salt not deposited onto the separate pieces of dough will fall into the collecting means and avoid entering into and fouling up the oven.

Plaintiff's claims in his patent are only five in number. In claim 1, plaintiff claims as his invention:

> "[A] conveyor belt . . . defining a plurality of spaced-apart openings having a maximum dimension whereby adequate support will be provided for the pieces and a minimum dimension which will permit passage of salt through the belt, said belt supporting said pieces as salt is deposited thereon and being completely independent of the conveying means for transporting the pieces to and from said station, whereby virtually all of the material which is not deposited on said pieces falls through the belt and is, therefore, not transported to said oven, and including a collecting means for said material located beneath both the upper and lower flights of said conveyor belt whereby said material passes through both flights before being collected by said collecting means.

Claims 2 through 5 all refer back to claim 1, with claim 2 describing the conveyor belt as a wire mesh belt, claim 3 describing the collecting pans as being removable so that the salt collected therein can be recycled, and claim 5 describing the collecting pan as portable so that it can be removed and replaced without disturbing the continuing operation of the machine. Claim 4 describes the air blowing device.

B. Defendant's Challenge to Plaintiff's Suit for Infringement

In the present motion for summary judgment, defendant asserts that plaintiff's patent No. 3,448,698 is invalid and therefore an action for infringement will not lie. As to the primary claim 1, as well as claims 2, 3, and 5, defendant relies on 35 U.S.C. §§102(a), (b) in arguing that the Namirowski invention is unpatentable. Sections 102(a) and (b) provide:

> A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . . .

Thus, defendant argues that the invention described in claims 1, 2, 3, and 5 was: (1) in *prior publication* before 1965, the earliest date ascribed to the invention's discovery; (2) *anticipated* by a prior patent and publications; (3) *in prior public use* and *on sale* in the United States more than one year before plaintiff's application for his patent; and (4) *not new* or *novel* in the light of prior art.

As to claim 4, defendant argues that it must fail since first, it is dependent for its validity on claim 1 which is invalid, and second, the claim violates 35 U.S.C. § 103 in that

> the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

1. The Validity of Claims 1, 2, 3, and 5.

In support of its position that the Namirowski patent is invalid on the grounds of prior publication and public use or sale, lack of novelty, and anticipation, defendant relies on British Patent No. 507,931, issued in 1939 to T. & T. Vicars Ltd. ("Vicars patent"), as well as machines used or sold by Schulze and Burch Biscuit Co., Tiefenthaler

Machinery Co., Thomas L. Green & Co., Inc., J. W. Greer, Inc., and Baker Perkins, Inc. The Vicars patent involves a device for "improvements in biscuit making machinery,"

> in which . . . salt . . . for dusting or spraying from the dusting or spraying device which does not come upon any dough biscuit is collected after passage through the open space of the reticulate conveyor [comprising an interlinked wire meshwork] and returned to the dusting or spraying device.

The other machines mentioned above, all in use prior to 1965, comprise devices used in the production of crackers in which unbaked cracker dough is sent by conveyor to a wire mesh belt positioned beneath a salting machine and which have a collecting mechanism to collect any excess salt which falls on the wire mesh belt. The collecting means in each machine is removable so that the collected salt can be reused in the production process.

Before proceeding to discuss the merits of defendant's arguments, the court notes that the greatest scrutiny of the record is required prior to a determination of a motion for summary judgment in a patent case. However, the Seventh Circuit has approved of summary judgment in patent litigation when it is clear that there are no genuine issues of *material* fact and a trial on the merits would be useless. *See Ropat Corp.* v. *McGraw-Edison Co.*, 535 F.2d 378 (7th Cir. 1976); *Research Corp.* v. *NASCO Indus.*, 501 F.2d 358 (7th Cir.), *cert. denied*, 419 U.S. 1096 (1974). Moreover, although the plaintiff argues that the presumption of patent validity mandates extreme caution in summary judgment motions challenging a patent's validity in this case, no such presumption exists. Thus, the cases of *Fredman* v. *Harris-Hub Co.*, 442 F.2d 210 (7th Cir. 1971), *T. P. Laboratories, Inc.* v. *Huge*, 371 F.2d 231 (7th Cir. 1966), and *Scott Paper Co.* v. *Fort Howard Paper Co.*, 432 F.2d 1198 (7th Cir. 1970), *cert. denied*, 401 U.S. 913 (1971), establish the principal that, "[T]here is no presumption of patent validity when the pertinent prior art was not before the patent examiner." *Fredman* v. *Harris-Hub Co.*, 442 F.2d 210, 214 (7th Cir. 1971). In the case at bar, neither the Vicars patent nor the other machines mentioned before was cited to the patent office in Namirowski's application for patent. Therefore, there is no presumption of validity as to U.S. Patent No. 3,448,698.

It is the court's conclusion, after reviewing the Vicars patent, and the affidavits presented describing the other machines used in the United States to bake crackers, that claims 1, 2, 3, and 5 are invalid pursuant to 35 U.S.C. §§ 102(a) and (b) on the grounds of prior publication and use, anticipation and lack of novelty. Claims 1, 2, 3, and 5 refer to two components which delineate the patentable aspect of plaintiff's device; a wire mesh conveyor belt that has holes large enough to allow salt to pass through, and a means for collecting the salt that fails to land on the unbaked cracker dough. All the machines mentioned previously, as well as the Vicars device, contain the identical wire mesh belt and portable collecting mechanism. As stated by the Seventh Circuit in *Popeil Bros., Inc.* v. *Schick Electric, Inc.*, 494 F.2d 162 (7th Cir. 1974):

> In essence Section 102(a) requires that a method or device, in order to be patentable be novel. Under the statute such novelty is lacking where a purported invention has been anticipated by a foreign or domestic patent or printed publication or domestic knowledge or use prior to the inventor's date of invention. A previous patent, printed publication or domestic product anticipates a purported invention only where, except for insubstantial differences, *it contains all of the*

same elements in the same fashion to perform an identical function.

Id. at 164 (emphasis supplied).

Plaintiff does not dispute that the Vicars patent and the other machines cited by defendant contain the same elements described by his patent in claims 1, 2, 3, and 5. Rather, plaintiff argues: (1) that the devices cited by the defendant are unworkable in that periodic cleaning of the baking ovens is still required whereas such cleaning is not required with the Namirowski patent and that the machines cited by defendant were not designed to perform the function of "eliminating" salt from the baking ovens; (2) that none of the devices cited by defendant contain a "noser assembly" as described in plaintiff's patent which supports the uncooked dough as it passes from conveyor to conveyor; and (3) that the Namirowski patent allows for reuse of the collected excess salt in a "quality control" situation whereas the defendant's devices pulverize the salt making it unfit for use in a "quality control" operation. However, on the basis of undisputed facts, these arguments do not rebut the arguments by defendant that the devices cited by defendant are identical in nature, function and purpose to the invention described in claims 1, 2, 3, and 5 of the Namirowski patent.

As to plaintiff's first argument, it is clear that the devices cited by the defendant were designed to eliminate salt from the baking ovens. Calling the Vicars patent a "recovery" device rather than an "elimination" machine can not dispel the clear language of that patent which states:

> By the present invention any desired treatment by powder . . . may be applied to the *biscuits whilst ensuring that excess material does not pass into the oven.*

Thus, the purposes of the Vicar patent and the Namirowski patent are identical.

Moreover, plaintiff's arguments that the Vicars patent is unworkable and that all the devices cited by defendant do not eliminate periodic cleaning of the baking ovens are without merit. First, plaintiff's sole basis for the belief that the Vicars patent is unworkable is his "opinion," and that of Mr. Dorkin, that the machine will not work. Neither man has seen a Vicars machine in operation and their "opinion" is based solely on a view of the patent's specifications. The affidavit of Mr. Barrett, a director of Simon-Vicars Ltd., conclusively shows that the Vicars device can operate to eliminate salt from entering the baking ovens during the baking of separate pieces of cracker dough. This affidavit is uncontroverted by plaintiff on the basis of any personal knowledge held by plaintiff. Second, although it is true that none of the affidavits presented concerning the operation of the devices cited by the defendant indicate whether or not periodic cleaning of the ovens is still necessary, this fact is irrelevant in the light of plaintiff's own admission that his machine, as defined in claims 1, 2, 3, and 5, will not eliminate salt from entering the baking ovens. Thus, on page 7 of plaintiff's own affidavit in opposition to defendant's motion, plaintiff admits that even with the wire mesh belt as he designed it, "after a while this excess salt built up on the wire mesh belt [and] would be thrown onto the oven band and into the oven."

In regard to the second and third arguments raised by plaintiff, all that need be noted is that neither the "noser assembly" nor the device used to prevent pulverization of the salt were ever mentioned in any of the patent claims. Thus, since the law is clear that it is the "claim of the patent [which] measures the grant," *Popeil Bros., Inc.* v.

Schick Electric, Inc., 356 F. Supp. 240, 252 (N.D. Ill. 1972), *aff'd* 494 F.2d 162 (7th Cir. 1974), such factual distinctions are irrelevant to whether or not the devices cited by the defendant anticipate the invention *claimed* by Namirowski in his patent. In other words, these factual differences do not create a genuine issue of *material* fact.

Therefore, since there are no genuine issues of material fact, claims 1, 2, 3, and 5 are declared invalid in that before 1965 there was in existence devices and prior publications describing devices which contained all the elements enumerated in those claims, which performed the same function in the same way as the machine defined in those claims, and whose purposes were to perform the same function as was performed by the device described in those claims. 35 U.S.C. §§ 102(a), (b); *Popeil Bros., Inc.* v. *Schick Electric, Inc.*, 494 F.2d 162 (7th Cir. 1974).

2. Validity of Claim 4.

Claim 4 describes a device containing a wire mesh conveyor belt and collecting means, as defined in claim 1, as well as an air blower which forces air against the wire mesh conveyor belt's return trip in order to dislodge any excess salt which might become stuck in the wire mesh openings. Defendant argues that, pursuant to 35 U.S.C. § 103, claim 4 is invalid in that all the elements included within the claim were in existence prior to the date of invention and that the *combination* of these known elements would have been obvious to one skilled in the art. In support of this argument, defendant presents several affidavits which state that *air hoses* were located along the cracker baking line although defendant does admit that air blowers were never attached to and in constant operation with the wire mesh belt. Plaintiff does not deny that all the elements of the device as described in claim 4 existed prior to

his discovery, but he argues that his invention could not have been obvious in light of the long felt need for such a device and the fact that Nabisco, a huge multinational corporation with a large research and patent department, could not solve the problem.

However, the recent Supreme Court decisions in *Sakraida* v. *Ag Pro, Inc.*, 96 S. Ct. 1532 (1976) and *Dann* v. *Johnston*, 96 S. Ct. 1393 (1976) make it clear that the plaintiff's claim 4 is obvious and invalid. In *Sakraida*, the Court pointed out that even if a device is commercially successful and fulfills a long-felt need in an industry, a combination patent is still obvious and invalid where the reordering of known elements fails to produce a synergistic result. 96 S. Ct. at 1537. Thus, before a court even considers whether or not there did exist a long-felt need for the purported invention, the court must determine that the combination of old elements produces a result greater than the sum of the parts. As the Court stated in invalidating the patent in issue in *Sakraida*,

> this patent simply arranges old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations. Such combinations are not patentable under standards appropriate for a combination patent.

Id.

In the case at bar, the "striking result" which occurred by the elimination of all excess salt from the baking ovens does not counter the fact that each old element still operates as it did prior to its repositioning in claim 4. In this regard, the facts of *Sakraida* are quite similar to the facts here. The patent in *Sakraida* involved a system using water to clean animal wastes from barn floors. The prior art disclosed that spot delivery of water by high pressure

hoses was used to clean barn floors in the past. The patent in issue provided for an abrupt release of water from a tank directly to the barn floor cleaning the floor in minutes.

As to Namirowski's claim 4, the prior art undisputedly shows that compressed air was used to clean the wire mesh belts and equipment in cracker manufacturing. All that claim 4 achieved, as did the *Sakraida* device, was a direct, continuous application of a prior known method. As such, claim 4 is obvious as it is simply not *new*.

C. Conclusion

Therefore, for the foregoing reasons it is this court's opinion that summary judgment is appropriate in this case as there exists no genuine issue of material fact. As the Supreme Court has stated in *Great A & P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950).

> Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements.

Id. at 152. It is the court's conclusion that the Namirowski patent does not contain that element of "newness" which is required to overcome the "improbability" of finding "invention" in a combination of old elements. Defendant's motion for summary judgment is hereby granted.

It is so ordered.

Joel M. Flaum
United States District Judge

Dated: September 15, 1976.

Supreme Court, U. S.
FILED
MAR 24 1978
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

No. 77-1198

A. M. NAMIROWSKI,
Petitioner,

vs.

NABISCO, INC., a foreign corporation,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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The five claims of petitioner's patent were all declared invalid by the District Court on motion for summary judgment. The District Court's opinion (Pet. App. 14-24) was affirmed and adopted by the Court of Appeals.

Four of the claims of petitioner's patent (numbers 1, 2, 3, and 5) were invalidated under 35 U.S.C. Sec. 102 (a) and (b), since they were fully anticipated by prior art. This prior art was exemplified by the 1939 British Patent No. 507,931 to Vicars, which discloses every element of claims 1, 2, 3, and 5, and every element of claim 4 except the blower. Undisputed evidence shows that the prior art exemplified in Vicars was also embodied in several machines in operation long before the date of petitioner's alleged invention. The Vicars patent had the

same purpose and result as that alleged in petitioner's patent—to keep excess salt out of the baking oven (Pet. App. 20, 21).

The remaining claim 4 added another element to the combination described in the other claims—the fixed positioning of a blower just before the biscuits would enter the oven. The undisputed evidence showed that the use of a detached blower for the same purpose was common and well known in the art prior to petitioner's alleged invention. The District Court held that, in light of the prior art, the rearrangement of a blower in a fixed position where it performed the same function it had previously performed, rather than leaving it detached, was obvious and hence claim 4 was invalid.

The Court of Appeals, after briefs and oral arguments, summarily affirmed the District Court for the reasons set forth in the latter's decision. In doing so, the Court of Appeals invoked its own Rule 35 (Pet. App. 10-13).

Petitioner requests a review of the decision of the Courts of Appeals on three grounds.

First, petitioner claims that Circuit Rule 35 or the Order entered in this case pursuant to said Rule, are unconstitutional because either one or both allegedly violates the due process and equal protection provisions of the Constitution and, according to petitioner, either one or both violates the orderly administration of justice and appellate procedure.

Second, petitioner claims that the District Court erred in deciding that petitioner's patent was not entitled to a presumption of validity and that this determination undermined the grant of summary judgment.

Third, petitioner claims that summary judgment should not have been granted because the *Graham* and *Sakraida* decisions precluded it and the District Court, sanctioned

by the Court of Appeals, ignored the demands of those decisions and ignored the basic requisites underlying summary judgment.

I. CIRCUIT RULE 35 AND THE ORDER ENTERED IN THIS CASE UNDER IT ARE CLEARLY VALID

Circuit Rule 35 and the Order entered in this case pursuant to it are clearly constitutional and promote the orderly administration of justice and appellate procedure.

The provisions of Circuit Rule 35 are entirely consistent with the Federal Rules Of Appellate Procedure (FRAP) adopted by Order of this Court on December 4, 1967 and as amended by the various Orders of this Court since that time. FRAP Rule 36 clearly provides for the entry of judgment "without an opinion" by the clerk of the Court of Appeals and directs the clerk to mail "the judgment if no opinion was written" to all parties. In its Recommendation and Report to the April 1972 Session of the Judicial Conference of the United States on the Publication of Courts of Appeals Opinions (Resp. App. 1), the Board of the Federal Judicial Center reported (in 1972):

> "Ten years ago there were estimates that published decisions of American courts approached two and a half million. Today it probably is nearer three million. *Common law in the United States could be crushed by its own weight if this continues unabated.*" (emphasis added)

Subsequent to this Report and Recommendation, all circuits adopted rules providing for unpublished decisions and most circuits adopted rules prohibiting the citation of such decisions in other cases.

Circuit Rule 35 was duly made by a majority of Judges of the Seventh Circuit Court of Appeals.

The Order of the Court of Appeals under Circuit Rule 35 finding petitioner's patent invalid specifically adopted the opinion of the District Court (Pet. App. 2). By so doing, it provided the specificity, the lack of which petitioner contends obstructed his right to prepare and file the Petition for Writ now before this Court.

Furthermore, the Order speaks for itself and clearly falls at least under provisions (c) (2) (ii) of Circuit Rule 35 relating to appeals concerning the application of recognized rules of law and presenting arguments which are sufficiently substantial to warrant explanation but are not of general interest or importance. However, Circuit Rule 35 also speaks for itself and it would be superfluous for the rule to require the Court of Appeals to designate in its Order pursuant to the rule the category under which the Order is issued.

The absence of a requirement to designate category did not preclude petitioner from filing a motion for rehearing before the Court of Appeals since both the Order and the Rule under which it was issued were provided to petitioner well within the period for making such motions in this case. As the record shows, petitioner made no motion for rehearing before the Court of Appeals.

This Court, in *Taylor* v. *McKeithen*, 407 U.S. 191, 92 S.Ct. 1980 (1972), has approved the practice of using judgment orders: "We of course, agree that the courts of appeals should have wide latitude in their decisions of whether or how to write opinions. That is especially true with respect to summary affirmances." (407 U.S. 194 at note 4, 92 S.Ct. 1982). The practice has also been approved by the Fifth Circuit Court of Appeals in *NLRB* v. *Amalgamated Clothing Workers of America*, 430 F.2d 966 (1970), and the Third Circuit Court of Appeals in *United States* v. *Baynes et al.*, 548 F.2d 481 (1977).

Circuit Court Rule 35 and the Order issued under it in this case do not diminish or otherwise adversely affect

the doctrine of stare decisis. The opinion of the District Court appears at 421 F.Supp. 349, and stands affirmed by the Court of Appeals. The considered judicial opinion of the three Judges comprising the Court of Appeals panel that heard and affirmed the appeal from the District Court obviously was that there was no real need for a written opinion at all, the law would receive no benefit from any discussion of the evidence which was held to be insufficient to create a genuine issue of fact, and an opinion would have no precedential value since the principles of law were well established. Petitioner's suggestions that the Court of Appeals has buried its decision, has avoided accountability, has subjected itself to an "appearance of impropriety" or is a part of "a world of watergates" is temerarious.

II. PETITIONER'S PATENT WAS NOT ENTITLED TO A PRESUMPTION OF VALIDITY

The presumption of validity provided by 35 U.S.C. 282 is intended to presume correctness in the decisions of the United States Patent and Trademark Office (PTO) in its function of issuing patents. The statute provides that a patent shall be presumed valid. As is the case with any presumption, the presumption of validity is rebuttable.

Respondent provided the District Court with invalidating prior art that was not cited and considered by the PTO when it examined and issued petitioner's patent. This invalidating prior art, described above and in the decision of the District Court, included the 1939 British Patent No. 507,931 to Vicars which clearly discloses the basic elements, function and results described and claimed in petitioner's patent and which is far more pertinent than the prior art cited and considered by the PTO when it decided to grant petitioner's patent. The District Court, therefore, was completely justified in finding that there

was no presumption of validity as to petitioner's patent. The Court of Appeals was equally correct in its affirmance.

III. SUMMARY JUDGMENT WAS PROPERLY GRANTED IN THIS CASE

FRCP Rule 56(e) sanctions the rendering of summary judgment if the pleadings, depositions, answers to interrogatories, and admissions on file, together with affidavits, if any, show that there is no *genuine* issue as to any *material* fact and that the moving party is entitled to judgment as a matter of law. Rule 56(e) requires that supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissable in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein.

No different standards are prescribed for summary judgment in cases where a jury demand has been made and logically the standards should be the same. The presence or absence of a jury demand cannot create a genuine issue of material fact where none exists; nor is the jury a competent body to determine questions of law such as whether or not a genuine issue of material fact exists or whether the moving party is entitled to judgment as a matter of law. Petitioner has not been "deprived of a trial by jury" in this case; there simply has been no need for fact finding.

This Court held that summary judgment procedures prescribed by court rules do not infringe the constitutional right of a party to a trial by jury in *Fidelity & Deposit Co. of Maryland* v. *United States*, 187 U.S. 315, 23 S.Ct. 120 (1902). Since promulgation of the Federal Rules of Civil Procedure, the issue of the constitutionality of FRCP Rule 56 has seldom been raised and, when it has been raised, constitutionality has always been sustained. (Moore's Federal Practice, Vol. 6, pages 56-88).

Petitioner does not contest the District Court's summary judgment of invalidity of claims 1, 2, 3 and 5, (Pet. App. 19) nor the affirmance by the Court of Appeals of the judgment below. These claims were invalidated pursuant to 35 U.S.C. 102(a) and (b) on the grounds of prior publications and use, anticipation and lack of novelty, apart from obviousness under 35 U.S.C. 103.

The invalidation of claim 4 as obvious was equally correct. The *Graham* decision by this Court states that commercial success, long felt but unsolved needs, failures of others, etc. "*might*" give light to circumstances surrounding the origin of the subject matter sought to be patented and "*may*" have relevancy as indicia of obviousness or nonobviousness. The later decision by this Court in *Anderson's Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969) made it quite clear that these matters without invention will not make patentability.

Claim 4 is based on a combination of elements, every one of which was shown to have been old in the art. Reference was made in the *Black Rock* case to the earlier case of *A&P Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147 (1950) where this Court cautioned that: "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."

The District Court in this case carefully followed the principles of these decisions of this Court as well as the *Sakraida* decision and found petitioner's only remaining claim (claim 4—utilizing an air blower for blowing salt from the belt before it enters the oven) to be also invalid as obvious under 35 U.S.C. 103.

The resemblances as well as differences between the present case and the *Sakraida* case decided by this Court in 1976, were recognized by the District Court as justify-

ing the invalidation of petitioner's claim 4. The District Court's initial decision in the *Sakraida* case was to grant summary judgment holding the patent involved invalid. The initial grant of summary judgment in *Sakraida* was, however, not based on prior art patents or publications but was based only on conclusory statements in affidavits and correspondence and, therefore, it was reversed and remanded (437 F.2d 101). The grant of summary judgment in the case at bar is solidly based on a 1939 publication, to wit, the Vicars British Patent and other publications and documents introduced by the supporting affidavits which were made on personal knowledge. These differences are controlling.

In the instant case there were no significant issues of fact concerning the state of the prior art at the time the District Court granted summary judgment. Petitioner before the District Court did not dispute and thus conceded that each element of claim 4 was old and well known in the art prior to petitioner's alleged invention (Pet. App. 22, 23). Petitioner also did not dispute before the District Court, and thus conceded, that each of the old elements in the combination claimed in claim 4 performed its usual well known function and no other, even in the claimed combination. Thus, no genuine issue of material fact existed regarding either the scope and content of the prior art, or differences between the prior art and claims at issues, or the level of ordinary skill in the art.

Petitioner's contention that more or all excess salt is removed by the combination claimed in claim 4 than by prior art combinations is moot, pursuant to the *Sakraida* decision, because combinations of old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations, are not patentable under standards appropriate for a combination patent.

Except for the slight difference in fact underlying the initial reversal of the grant of summary judgment in the *Sakraida* case, the facts and law of the *Sakraida* decision fit the present case precisely and petitioner's claim 4 was properly invalidated.

On the basis of the foregoing arguments, respondent urges that the Petition for a Writ of Certiorari be denied.

Respectfully submitted,

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APPENDIX

APPENDIX

THE BOARD OF THE FEDERAL JUDICIAL CENTER

Recommendation and Report
to the
April 1972 Session
of the
Judicial Conference of the United States
on the
Publication of Courts of Appeals Opinions

PUBLICATION OF COURTS OF APPEALS OPINIONS

Recommendation

The Judicial Conference should direct that each circuit council should review the publication policy within the circuit and consider the adoption of modifications designed to eliminate unnecessary publication of opinions. Such modifications should include a policy that:

a. Opinions will not be published unless ordered by a majority of the panel rendering decision;

b. Non-published opinions should not be cited, either in briefs or in court opinions;

c. Where an opinion is not published, the public record shall be completed by publishing the judgment of the court.

Further, the Judicial Conference should request that the circuit councils report developments regarding this resolution in one year.

Report

Reducing the number of opinions published in the official reports appears to be a goal so widely shared among the judiciary and the legal community as to require no demonstration by research or formal investigation. The reasons for apprehension over unlimited publication arise from every segment of bench and bar:

a. Unlimited proliferation of published opinions constitutes a burden and a threat to a cohesive body of law. Ten years ago there were estimates that published decisions of American courts approached two and a half million. Today it probably is nearer three million. Common law in the United States could be crushed by its own weight if this continues unabated.

b. Publication of opinions places an extremely heavy burden on the courts. First is the burden of writing opinions. While a limitation on the publication of opinions, in and of itself, does not reduce the number of opinions to be written, it affects greatly the time and resources that must be devoted to opinion preparation. An opinion prepared to inform the parties of the reasons for the decision is quite a different thing from an opinion that will be published and incorporated into the body of precedent. A judge should be able to present his reasoning to the parties without having to acquit his legal scholarship in every opinion. The second burden for the courts is the accountability for consideration of *every* opinion that has *ever* been written.

c. The burden on counsel is commensurate with that of the bench in terms of accountability in preparing their cases. The endless search for factual analogy requires immense expenditure of time and funds that can result in reliance upon quirks rather than careful rationalization and application of the developing law.

d. The logistical burden for courts and practitioners has become dangerously heavy. . . . Posting, maintenance, shelving, and librarian services result in time and money costs disproportionate to the value of the materials.

e. The burden on the publishing industry to continue to supply a complete reporting service at prices that are tolerable.

The Federal Judicial Center has consulted with a number of circuit judges concerning their policies now in effect and their views about the essential elements of a workable method for more effective limitation. The Center also addressed inquiries to several state court systems

known or believed to be applying systematic procedures to publication. From every source, the responses confirm the view that more is being published that is required. Procedures to limit publication range from none at all to the establishment of review bodies external to the courts who decide which opinions to publish and which not. Predictably, those courts with no policy or procedure report little change over the year in the rate of publication; those with review bodies or other fairly restrictive policies report that the ratio of unpublished to published opinions is increasing. The Board has not been convinced on the basis of presently available experience and information that external review boards are necessary or desirable. On the contrary such procedures necessarily entail the establishment of some opportunity for appeal when a judge or panel disagrees with the reviewers. Furthermore, the participation of the writing judge or the deciding panel in the decision not to publish seems likely to assure a more firmly founded policy and greater commitment to it. Accordingly, the Board's recommendation is that the decision to publish be made by those who decide and write.

The Board also recommends that publication policy should embody a presumption against publication. This casts the decision on publication in a positive form, finding that the opinion is one of such general and pervasive significance as to require notice to the legal community and to the public. A decision not to publish does not go to the merits of the opinion but only to the significance of the underlying issues.

Once an opinion has been designated not for publication, it should not be cited as authority either by the court that rendered it or by attorneys appearing before the court. A judge writing primarily for the benefit of the parties is entitled to assume a degree of familiarity with the background of a case, thus enabling him to set

forth only enough to inform the parties of the reasons for the court's decision. An opinion so prepared and directed should not be required to set forth all the material and reasoning which might be necessary for opinions directed to the world at large and intended to enter the body of precedent.

The recommendations urge each circuit to develop and announce a publication policy containing these elements. No attempt has been made here to identify the substantive content standards to guide the publication decision. It is believed that this task can best be performed in each circuit where the body of circuit law is most fully understood. A policy should be designed to enhance the development of each circuit's needs as perceived by the circuit council.

The Advisory Council for Appellate Justice, a group of judges, practitioners and scholars concerned with appellate processes and structures, is now considering the formulation of recommended guidelines for publication of appellate opinions at all levels of court systems throughout the country. The Federal Judicial Center and the National Center for State Courts are working closely with this group. Their report on opinion publication should soon be completed; and the Center will distribute it to all circuit judges for their consideration in developing circuit policy.